

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 14425US02)**

In the Application of:

Koenck, et al.

Serial No.: 10/787,443

Filed: Feb. 26, 2004

For: MODULAR PORTABLE DATA  
PROCESSING TERMINAL FOR USE  
IN A COMMUNICATION  
NETWORK

Examiner: Chery, Dady

Group Art Unit: 2461

Confirmation. No: 7829

Customer No: 23446

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted via EFS-Web to the United States Patent and Trademark Office on July 14, 2011.

/Shawn L. Peterson/

Shawn L. Peterson

Reg. No. 44,286

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on Feb. 14, 2011 ("Final Office Action") with a period of reply through July 14, 2011 with a two-month extension of time. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

**REMARKS**

The present application includes pending claims 1-31. Claims 1-5, 8-13, 16-20, 23-27 and 30-31 have been rejected. Claims 6-7, 14-15, 21-22 and 28-29 stand objected to, but would be allowable if written in independent form. The Applicants respectfully submit that the claims define patentable subject matter.

**I. Claims 1-5, 7, 9-13, 17-20, 24-27 and 31 are patentable over *Tymes***

Claims 1-5, 7, 9-13, 17-20, 24-27 and 31 stand rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,157,687 to *Tymes* (“*Tymes*”). Without conceding that *Tymes* qualifies as prior art to the present claims, the Applicants respectfully traverse such rejections.

**A. Independent Claim 1**

Independent claim 1 is patentable. The current rejection of claim 1 does not meet the mandates of the MPEP for providing a *prima facie* case of obviousness for multiple reasons.

First, for example, the *Tymes* base station 13 is not “a mobile computing device”. The *Tymes* base station 13 is an infrastructure device that communicates with the *Tymes* remote units 15. For example, as explained at col. 3 lines 21-24, the *Tymes* base stations are assigned to respective rooms or coverage areas. Also, as explained at col. 7 lines 36-58, the *Tymes* base stations are assigned to respective rooms or bays of a commercial establishment, where the base stations may be wall-mounted or desktop. Additionally, as explained at col. 8 lines 1-3, a base station may be “mounted” at the same location as the network host computer. Thus, the *Tymes* base station 13 is indeed stationary.

In response the above comments, on page 2 of the Final Office Action, the Examiner makes a number of comments, each of which will now be addressed.

The Examiner first states that because the *Tymes* base station 13 is “an accessible device”, this means that such base station is “a mobile computing device”. Since most if not all stationary non-mobile devices are “accessible”, such position is clearly unreasonable.

The Examiner then states that because the *Tymes* base station 13 communicates with a mobile device, “that makes it a communicating mobile device”. Since merely communicating with a mobile device does not make a base station a mobile device, such a position is clearly unreasonable.

The Examiner lastly adopts the broad conclusory position that it is always obvious to make a stationary device into a mobile device. Such a position is clearly overbroad and unsupported in the present factual circumstances. For example, as shown in Figure 3 and discussed at col. 6, lines 48-62, the *Tymes* base station 13 is a wired infrastructure device. Simply converting the *Tymes* base station 13 to a mobile device would be unreasonable. Additionally, base stations generally have substantially different operating goals and needs than mobile devices. Accordingly, the Examiner’s overbroad position clearly does not meet the mandates of MPEP § 2142, stating in part, “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”.

Since none of the Examiner’s argument responses are reasonable, and none of such remarks meet the mandates of the MPEP for supporting a *prima facie* case of obviousness, the Applicants submit that independent claim 1 is allowable as are all claims depending therefrom, including claims 2-10.

Secondly, in alleging that *Tymes* shows a mobile computing device comprising the claimed “communication processor”, the Final Office Action at pages 6-7 states, “*Tymes* further teaches the base station in the host device may be considered as a single device (col. 8, lines 1-7); which is substantially implies the processor (20) of the host computer is incorporate to the base station, therefore, coupled between the base processing unit and the first and second communication transceivers.” For multiple reasons, the Applicants respectfully disagree.

First, at col. 8 lines 1-7, *Tymes* merely discusses co-locating a base station and the network host computer and connecting such distinct entities with a parallel bus-to-bus interface, *not* physically combining such units. Secondly, even if for the sake of argument only a *Tymes* base station and a network host computer were combined in a single device, such a device would certainly not be a mobile device.

The Examiner offered no response to the Applicants' clear and well-reasoned position. Accordingly, for at least this additional reason, the Applicants submit that independent claim 1 is allowable as are all claims depending therefrom, including claims 2-10.

## B. Independent Claims 2-5, 7, 9 and 10

Turning next to dependent claim 2, the Final Office Action, at pages 7-8, states that the *Tymes* communication adapter 33 teaches the claimed "first processing unit", and the *Tymes* RF transceiver 34 teaches the claimed "second processing unit. The Applicants respectfully disagree.

For example, in discussing claim 1, from which claim 2 depends, the Final Office Action asserts that the *Tymes* base station 13 is the claimed "mobile computing device", the *Tymes* communication adapter 33 is the claimed "first communication transceiver", the *Tymes* RF transceiver 34 is the claimed "second communication transceiver", and the base station CPU 30 is the claimed "base processing unit".

Now, however, the Final Office Action is essentially stating that the *Tymes* communication adapter 33 is coupled between the *Tymes* communication adapter 33 and the *Tymes* CPU 30. In other words, the Final Office Action has adopted the position that the communication adapter 33 is coupled between itself and the CPU 30. Such a position is clearly untenable. Similarly, the Office Action is adopting the position that the *Tymes* RF transceiver 34 is coupled between the RF transceiver 34 and the CPU 30, again coupled between itself and the CPU 30. Such a position is similarly untenable.

In response to such position, the Final Office Action at page 2 states, "the processing unit (comm.. adapter 33) is couple[d] to CPU 30 considered as the base processing unit and the communication transceiver item 25". It is unclear how such statement addresses the Applicants' position. For example, the item 25 is a communication adapter of the host, which is completely separate from the base station 13. Additionally, if the Examiner now desires to reformulate the rejection, assigning different elements of the *Tymes* system to different elements of the claim, the Examiner's rejection must clearly identify each element of the claim, including those elements in claim 2 through its dependency of claim 1.

Accordingly, for at least these additional reasons, the Applicants submit that claim 2 is allowable over *Tymes*.

Turning next to dependent claim 3, the Examiner's position again relies on the mischaracterization of the *Tymes* base station 13 as "a mobile computing device". As explained above, such position is clearly unreasonable.

Turning next to dependent claim 4, the Final Office Action at page 8 states that *Tymes* "discloses the system of claim 3 wherein the wireless subnetwork comprises a backup network in the event of a failure in the wired subnetwork (Fig. 1, where the RF network between base station 14 and base station 13 is considered as the backup network)". The Applicants respectfully disagree with such characterization of *Tymes*.

In discussing claim 1, from which claim 4 depends, the Final Office Action alleges that the *Tymes* communication link 11 is the claimed “first subnetwork” and the *Tymes* wireless RF network is the claimed “second subnetwork”. Since, in the analysis of claim 4, the Final Office Action does not revisit the discussion of the elements of claim 1 that are part of claim 4 through dependency, the Applicants must assume that the Final Office Action is relying on the analysis of claim 1 for such elements. Such being the case, the Applicants were unable to find any mention of a wireless RF network of *Tymes* being utilized as a backup network in the event of a failure of the communication link 11 of *Tymes*.

In response to the above-stated position, the Final Office Action, at page 3, states “*Tymes* disclose[s] multiple wireless networks such as the RF connection with base stations (12, 13, and 14). Therefore *Tymes* discloses a backup network in the event of a failure.” Such comment is clearly incorrect. For example, even if for the sake of argument only, the *Tymes* system discloses the RF connections with base stations, there is still no mention in *Tymes* of a wireless RF network being utilized as a backup network in the event of a failure of the communication link 11 of *Tymes*.

Accordingly, for at least this additional reason, the Applicants submit that claim 4 is allowable over *Tymes*, as are all claims depending therefrom, including claims 5-7. The Applicants also submit that each of claims 5-7 is allowable.

Turning next to dependent claims 5, 9 and 10, the Examiner’s position repeatedly relies on the mischaracterization of the *Tymes* base station 13 as “a mobile computing device”. As explained above, such position is clearly unreasonable.

### **C. Remaining Claims 11-13, 17-20, 24-27 and 31**

Turning next to claims 11-13 and 17, such claims share various characteristics with claims 1-3 and 9, discussed previously. Accordingly, the Applicants submit that claims 11-13 and 17 are allowable for at least reasons generally analogous to those discussed previously with regard to claims 1-3 and 9, respectively and where reasonably applicable.

Turning next to claims 18-20 and 24, such claims share various characteristics with claims 1-3 and 9, discussed previously. Accordingly, the Applicants submit that claims 18-20 and 24 are allowable for at least reasons generally analogous to those discussed previously with regard to claims 1-3 and 9, respectively and where reasonably applicable.

Turning next to claims 25-27 and 31, such claims share various characteristics with claims 1-3 and 9, discussed previously. Accordingly, the Applicants submit that claims 25-27 and 31 are allowable for at least reasons generally analogous to those discussed previously with regard to claims 1-3 and 9, respectively and where reasonably applicable.

## **II. Claims 8, 16, 23 and 30 are patentable over *Tymes* and *Wang***

Claims 8, 16, 23 and 30 stand rejected under U.S.C. § 103(a) as being unpatentable over *Tymes* in view of U.S. Patent No. 5,157,687 to Wang (“*Wang*”). Without conceding that *Tymes* and *Wang* qualify as prior art to the present claims, the Applicants respectfully traverse such rejections.

### **A. Dependent Claim 8**

The Office Action, at page 10, states that *Tymes* does not teach that the communication module is housed on a PCMCIA card. The Applicants agree. Then, however, the Office Action states that since

Appl. No. 10/787,443

Pre-Appeal Brief dated July 14, 2011

Resp. to Final Office Action of Feb. 14, 2011

*Wang* teaches that a communication module can be disposed on a PCMCIA card it would have been obvious to one of ordinary skill in the art to place the alleged communication module of *Tymes* (*i.e.*, the *Tymes* base station 13) on a PCMCIA card. The Applicants respectfully disagree with such statement.

First, for example, the claimed “communication module” comprises the first communication transceiver and the second communication transceiver. The *Wang* adapter card 100, however, does not comprise transceivers. For example, as illustrated at FIG. 1 and discussed at col. 4 lines 12-28, the *Wang* adapter card 100 does not comprise the RF communication module 120. Thus, even if one incorporated the *Wang* card into the *Tymes* system, the resulting system would not comprise the claimed “communication module” housed in a PCMCIA card.

In response to the above statement provided by the Applicants’ in the previous response, rather than address the Applicants’ clear and well-reasoned position, the Examiner merely repeated the language of the original rejection.

Accordingly, for at least these additional reasons, the Applicants submit that claim 8 is allowable over *Tymes* and/or *Wang*, individually or in reasonable combination.

### **B. Dependent Claims 16, 23 and 30**

Turning next to claims 16, 23 and 30, such claims share various characteristics with claim 8, discussed previously. Accordingly, the Applicants submit that claims 16, 23 and 30 are allowable for at least reasons generally analogous to those discussed previously with regard to claim 8, where reasonably applicable.

*In general, the Final Office Action makes various statements regarding claims 1-31 and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).*

### **III. Conclusion**

The Applicants respectfully submit that claims 1-31 of the present application are in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Date: July 14, 2011

Respectfully submitted,

/Shawn L. Peterson/

Shawn L. Peterson

Reg. No. 44,286

Attorney for the Applicant

McANDREWS, HELD & MALLOY, LTD.  
500 W. Madison, Suite 3400  
Chicago, IL 60661  
Telephone: (312) 775-8000